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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/385,315	08/30/1999	WILLIAM M. PARROTT	008193-20002	8973

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EXAMINER
VAUGHN JR, WILLIAM C

ART UNIT	PAPER NUMBER
2142	18

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/385,315	Applicant(s) PARROTT, WILLIAM M.	
	Examiner William C. Vaughn, Jr.	Art Unit 2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 December 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

WCV

DETAILED ACTION

1. This Action is in response to the Request for Reconsideration received 23 December 2002.

2. Amendment B, Paper 17, received 23 December 2002 has been entered into record.

Continued Prosecution Application

3. The request filed on 18 December 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/385,315 is acceptable and a CPA has been established. An action on the CPA follows.

4. The application has been examined. **Claims 1-23** are pending. The objections and rejections cited are as stated below:

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. **Claims 1-2, 4-11, 13-14, 16, 17 and 22** are rejected under 35 U.S.C. 102(a) as being anticipated by Kobayashi UK Patent Application 234920.

7. Regarding **claim 1**, Kobayashi *teaches an adapter* (option apparatus page 1, lines 4-7 and page 2 line1) *for connecting an infrared data port* (infrared type connection apparatus 1, see figure 2a & figure 5b) *to a radio frequency data system* (page 35, line 23-27 & page 36, line 1-5 portable phone antenna and base station), *comprising: an infrared transceiver* (Infrared Transmitter/Receiver circuit page 14, lines 12-15) *for sending and receiving information to and*

from the infrared data port (page 35, lines 23-27*); a radio frequency transceiver* (Radio Transmitter/Receiver circuit page 12, lines 15-20*) for sending and receiving information to and from the radio frequency data system* (36, lines 1-4*); and a processor* (see control circuit page 13, line 5-6, page 15, lines 5-25 and page 35, lines 7-9) *in communication with the infrared transceiver and the radio frequency transceiver* (page 15, lines 18-25) *for converting information received from the infrared transceiver to a radio frequency format* (page 9, lines 8-11) *for transfer to the radio frequency data system and for converting information received from the radio frequency transceiver to an infrared format* (page 9, lines 8-13) *for transfer to the infrared data port*. By this rationale **claim 1** is rejected.

8. Regarding **claim 2**, Kobayashi further teaches *comprising a buffer* (see memory circuit page 13 line 15) *for temporary information storage*. By this rationale **claim 2** is rejected.

9. Regarding **claim 4**, Kobayashi further *teaches wherein the infrared transceiver includes a driver circuit* (Transceiver/Receiver circuit page 14, lines 12-15) *for sending information to the infrared data port*. By this rationale **claim 4** is rejected.

10. Regarding **claim 5**, Kobayashi further *teaches wherein the infrared transceiver includes a receiving circuit* (Transceiver/Receiver circuit page 12, lines 15-20) *for receiving information from the infrared data port*. By this rationale **claim 5** is rejected.

11. Regarding **claim 6**, Kobayashi further teaches comprising a housing (page 22, lines 14-16 & see option apparatus for portable telephone Figure 5b). By this rationale **claim 6** is rejected.

12. Regarding **claim 7**, Kobayashi further *teaches a system for wirelessly connecting a computing device* (see Figure 9 portable type computer) *to a network* (see page 35 lines 1-13 base station, portable telephone, and portable computer comprise a network*), comprising: a*

computing device; an infrared data port connected to the computing device (figure 9 infrared type connection apparatus 31), *the infrared port configured to send and receive information to a radio frequency data system* (page 35, lines 13-15), *the radio frequency* data system (page 35, lines 1-3) *in communication with the network and configured to send and receive information* (page 35, lines 15-17 & page 36 lines 4-8); *and an adapter configured to transfer information between the infrared data port and the radio frequency data system* (Figure 9 option apparatus for portable telephone 1), *the adapter including: an infrared transceiver for sending and receiving information to and from the infrared data port* (page 35, lines 23-27); *a radio frequency transceiver for sending and receiving information to and from the radio frequency data system page* (36, lines 1-4); and a microprocessor (see figure 3 control circuit CPU 120*) in communication with the infrared transceiver and the radio frequency transceiver* (figure 9 radio transmitter/receiver 11 and infrared transmitter/receiver 163) *for converting information received from the infrared transceiver to a radio frequency format* (page 9, lines 8-11) *for transfer to the radio frequency data system and for converting information received from the radio frequency transceiver to an infrared format* (page 9, lines 8-13) *for transfer to the infrared data port* (page 13, lines 7-13). By this rationale **claim 7** is rejected.

13. Regarding **claim 8**, Kobayashi further teaches, *wherein the computing device is a portable computer* (see figure 9 portable type computer). By this rationale **claim 8** is rejected.

14. Regarding **claim 9**, Kobayashi further *teaches wherein the adapter physically connects to the computing device* (page 2, lines 21-23). By this rationale **claim 9** is rejected.

15. Regarding **claim 10**, Kobayashi further teaches *wherein the adapter is a stand-alone unit* (semi-fixedly inserted page 22, lines 14-16 & see option apparatus for portable telephone Figure

5b) *that communicates with the computing device* (see figure 4 portable telephone comprises control circuit 22 w/CPU 120) over an infrared communication link (see figure 5b infrared type connection apparatus 29 & 16). By this rationale **claim 10** is rejected.

16. Regarding **claim 11**, Kobayashi further *teaches wherein the adapter further comprises a buffer* (see memory circuit page 13, line 15*) providing temporary information storage*. By this rationale **claim 11** is rejected.

17. Regarding **claim 13**, Kobayashi further teaches *wherein the infrared transceiver includes a driver circuit for sending information to the infrared data port* (page 14, lines 12-15). By this rationale **claim 13** is rejected.

18. Regarding **claim 14**, Kobayashi further teaches *wherein the infrared transceiver includes a receiving circuit for receiving information from the infrared data port* (page 12, lines 15-20). By this rationale **claim 14** is rejected.

19. Regarding **claim 16**, Kobayashi further *teaches a method for wirelessly connecting a computing device to a network* (see Figure 9 portable type computer & see page 35 lines 1-13 base station, portable telephone, and portable computer comprise a network*), comprising: receiving information over an infrared communication link from a remote computing device* (page 35, lines 18-23); *converting the information from an infrared format to a radio frequency format* (page 36, lines 1-4*); and communicating the information to the network over a radio frequency link* (page 36, lines 4-5). By this rationale **claim 16** is rejected.

20. Regarding **claim 17**, Kobayashi further teaches *receiving information over a radio frequency communication link from the network* (see page 35 lines 1-13 base station, portable telephone, and portable computer comprise a network). By this rationale **claim 17** is rejected.

21. Regarding **claim 22**, the limitations of this claim are substantially the same as that of claim 1, and are thus rejected for the same rationale in rejecting claim 1.

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

23. **Claims 3, 12, 15, 18-21 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi UK Patent Application 234920.

24. Regarding **claim 3**, Kobayashi teaches the invention as claimed as noted above. Kobayashi does not explicitly teach the adapter further comprising a power supply in communication with the processor. Kobayashi teaches *the adapter* (option apparatus) *for the telephone is electrically connected to the portable telephone* (page 2, lines 21-23). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kobayashi to include a power supply because in order for the adapter to be electrically connected a power supply must be present. By this rationale **claim 3** is rejected.

25. Regarding **claim 12**, Kobayashi teaches the invention as claimed as noted above; However, Kobayashi does not explicitly teach, the adapter further *comprises a power supply in communication with the microprocessor*. Kobayashi teaches *the adapter* (option apparatus) *for the telephone is electrically connected to the portable telephone* (page 2, lines 21-23). By this rationale **claim 12** is rejected.

26. Regarding **claim 15**, Kobayashi teaches the invention substantially as claimed as noted above. Kobayashi does not teach a plurality of computing devices having infrared data ports, a plurality of infrared transceivers, and processing means in communication with the plurality of infrared transceivers and the radio frequency transceiver for converting information received from the plurality of infrared transceivers to a radio frequency format for transfer to the radio frequency data system and for converting information received from the radio frequency transceiver to an infrared format for transfer to at least one of the infrared data ports. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a plurality of computing devices having infrared data ports, a plurality of infrared transceivers, and a processing means in communication with said plurality of infrared transceivers because the optimization of proportions in a prior art device is a design consideration within the skill of the art. In re Reese, 290 F.2d 839, 129 USPQ 402 (CCPA 1961).

27. Regarding **claim 18**, Kobayashi teaches the invention as claimed as noted above. Kobayashi further teaches, wherein the radio frequency format conforms to Bluetooth protocol **[page 36, line 1-5]**. However, Kobayashi does not explicitly disclose radio frequency format conforms to Bluetooth. (The inclusion of radio frequency format that conforms to Bluetooth protocol would have been obvious to one of ordinary skill in the networking art at the time the invention was made in view of the notoriously widely known and widely implementation of radio frequency format conforming to Bluetooth protocol in the wireless and networking art. The Examiner takes Official Notice (MPEP 2144.03) that "Bluetooth protocol is well known in the networking art at the time the invention was made as exemplified by several of the patents cited as relevant for this application (see Eichstaedt et al., U.S. Patent No. 6,218,958, Col. 1,

lines 23-35 and Col. 3, lines 44-55). The Applicant is entitled to traverse the official notice according to MPEP 2144.03. However, MPEP 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, *In re Boon*, 169 USPQ 231, 234 states "as we held in Ahlert, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further 37 CFR 1.671©(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given little weight). And thus, since Kobayashi does provide motivation to utilize Bluetooth protocol through the use of a portable terminal unit, one of ordinary skill in the art would have provided provisions to utilize this protocol being that it is a standard for radio communication between electronic devices, developed and trademarked by the Bluetooth Consortium which allows for computer peripherals to communicate without cables, using radio frequencies for short-range exchange of data. For example, using your Bluetooth-equipped PC you could synchronize your telephone number list from your contact manager software with your Bluetooth-capable cell phone.

28. **Claims 19-20 and 23** contain similar limitations to the method claimed in claim 18, therefore claims 19-20 and 23 are rejected under the same rationale.

29. Regarding **claim 21**, Kobayashi further teaches wherein the adapter further comprises a buffer to provide temporary information storage **[memory circuit page 13 line 15].** By this rationale **claim 21** is rejected.

Response to Arguments

30. Applicant's arguments filed on 23 December 2002 have been carefully considered but they are not deemed fully persuasive. However, because there exists the likelihood of future presentation of this argument, the Examiner thinks that it is prudent to address applicants' main points of contention.

(A) Applicant contends that Kobayashi fails to teach that a processor converts information received from the infrared transceiver to a radio frequency format and that converts information received from the radio frequency transceiver to an infrared format.

(B) Applicant also argues that Kobayahsi does not teach or suggest a radio frequency system that is a network interface that facilitates communication between the IR and RF adapter and the network.

31. As to "Point A", it is the Examiner's position as stated in paper 12, that Kobayashi does in fact to this particular limitation as well as other claimed limitation. Specifically, with regards to Kobayashi teaching the conversion from IR to RF and RF to IR **[page 9, lines 8-13].** Kobayashi further teaches a control circuit comprising a processor (CPU) **[figure 3, control circuit 12].** This processor of the control circuit is shown to process signals between transceivers **[page 13, lines 8-11]** and convert signals into IR **[page 35, lines 7-9].** Examiner would like to also direct Applicant to the portions of their specification (page 6, starting at line 7) that does not explicitly go into the actual details of how this conversion process takes place. The

specification states that, "the IR to RF adapter (140) receives the information over an IR communication link, converts the information from an IR format to an RF format compatible with RF data system (130), and transfers the information to network 120 via RF data system (130)." Also, Applicant further implicitly states that the conversion involves changing the communication protocol from an IR format to a RF format compatible with RF data system (see page 6, lines 25-32. Applicant also states that there is a program to do this conversion. Examiner would like to know where this program is within the specification. With regards to Kobayashi teaches that the radio transmitter/receiver circuit converts the transmission data into a radio signal by the antenna [see Kobayashi, pages 14 and 36].

32. As to "Point B", it is the Examiner's position that Kobayashi does in fact teach a radio frequency system that is a network interface that facilitates communication between the IR and RF adapter and the network. Kobayashi teaches that the adapter allows for information to be transmitted to and from the portable type personal computer and the infrared type connection apparatus [see Kobayashi, Figure 9, pages 35 and 36]. As Applicant's specification states that information is transmitted across the IR communication link [see Applicant's specification, page 5, lines 12-16].

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Vaughn, Jr. whose telephone number is (703) 306-9129. The examiner can normally be reached on 8:00-5:00, 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Powell can be reached on (703) 305-9703. The fax phone numbers for the

organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9700.

WCV

WCV
Patent Examiner
Art Unit 2142
March 3, 2003

MARK POWELL
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